1616

PATENT

Attorney Docket No. 07191.0009
Honeywell Docket No. 30-3986 DIVI(CFA)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Paul G. CLEMMER et al.

Application No.: 08/959,748

Filed: October 28, 1997

For: PROCESS FOR PRODUCTION OF DIFLUOROMETHANE

Group Art Unit: 1616

Examiner: A. Pryor

Assistant Commissioner for Patents
Washington D.C. 20231

RESPONSE

Applicants provide the following comments in response to the Office Action dated October 3, 2000. A response is due by January 3, 2001.

Claim 1 was rejected for a second time under 35 U.S.C. § 112, second paragraph. In addition, the Examiner reinstated several rejections under 35 U.S.C. § 102(a, e).

The Examiner's rejections are improper or overcome, should be withdrawn, and all claims placed in condition for allowance. Upon allowance, Applicants request that an interference be declared with U.S. Patent No. 5,672,786.

The Examiner's rejection under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn. 35 U.S.C. § 112, second paragraph, provides:

> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention."

The Examiner fails to explain how 35 U.S.C. § 112, second paragraph, is being applied to claim 1. Indeed, the rejection appears to be based on Applicants' submission of a declaration under 37 CFR § 1.131 and, in particular, Exhibit A of that declaration. The

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Examiner argues that claim 1 should be rejected under 35 U.S.C. § 112, second paragraph because he was unable to find support for the HF:FClCH2 ratio of 100:1 in Exhibit A. The Examiner is rejecting the substance of Exhibit A of the Rule 131 proofs, not claim 1. Accordingly, the § 112 rejection is improper. Moreover, as Applicants note in their July 24, 2000 response, whether or not Exhibit A shows or supports the ratio of 100:1 is irrelevant. Applicants demonstrated in their Rule 131 declaration, and the Examiner has not challenged that proof, that the invention was successfully reduced to practice prior to September 29, 1994. See paragraphs 4-6 of the Rule 131 declaration. Applicants' reduction to practice date is prior to the earliest publication date of the references relied upon by the Examiner to support the PTO's 35 U.S.C. § 102 rejections. Because Applicants' reduction to practice date antedates the references relied upon by the Examiner, both rejections under 35 U.S.C. § 102 are overcome.

The Examiner has failed to explain why the Applicants are required to show an earlier conception date, the focus of Exhibit A. Exhibit A at this time is not material to whether the Applicants have successfully removed the prior art.

In summary, the rejection under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn. The rejections under 35 U.S.C. § 102 have been overcome and should also be withdrawn. The claims are in condition for allowance, and the requested interference should be declared.

Respectfully submitted,

Date: January 2, 2001

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